

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK L. YOSELOFF and ROGER M. SNOW

Appeal No. 2007-2074
Application No. 10/658,863
Technology Center 3700

Decided¹: July 24, 2007

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHR,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

This is an appeal from a decision of the Examiner rejecting claims 1-28. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The grounds of rejection to be reviewed on appeal are:

¹ An oral hearing was conducted at 9:00 a.m., July 12, 2007.

1. Claims 1, 2, 6, 8-11, 15, 18-21, and 24-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, stand rejected under 35 U.S.C. § 103(a) as obvious over de Keller (US Patent No. 5,975,529).
2. Claims 22 and 23 stand rejected under 35 U.S.C. §103(a) as obvious over de Keller.
3. Claims 3-5, 7, 12-14, 16, and 17 stand rejected under 35 U.S.C. §103(a) as obvious over de Keller and further in view of Breeding (US Patent No. 5,288,529). Answer² 3 and Br.³ 9.

All the appealed claims have been rejected over at least de Keller. Based on the statements of the rejections, it appears that the Examiner has taken the position that de Keller is legally available as prior art under 35 U.S.C. §102(b). De Keller can only be legally available as prior art under 35 U.S.C. §102(b) if the present application has an effective filing date that is at least one year *after* de Keller's critical date (i.e., after November 2, 1999, de Keller's issue date). As we further explain below, the effective filing date of the present application, and concomitantly the legal availability of de Keller, requires establishing that the subject matter of the appealed claims is *not entitled* to the benefit under 35 U.S.C. § 120 of the filing dates of 10/016,436, 09/249,118, 09/170,092, 08/889,919, or 08/504,023.

² Mailed September 11, 2006.

³ **"REPLACEMENT BRIEF ON APPEAL,"** filed June 26, 2006.

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Appellants have claimed priority under 35 U.S.C. § 120 for the filing dates of these earlier-filed applications⁴:

10/016,436, filed April 29, 2002⁵;
09/249,118, filed February 2, 1999⁶;
09/170,092, filed October 13, 1998;
08/889,919, filed July 10, 1997; and,
08/504,023, filed July 19, 1995.

Accordingly, there is a presumption that the present application has an effective filing date of at least July 19, 1995. That date is *before* de Keller's filing date (September 11, 1995) and issue date (November 2, 1999). De Keller therefore

⁴ "This application is a continuation-in-part of U.S. Patent Application Serial No. 10/016,436, filed April 29, 2002, titled Player Banked Three Card Poker and Associated Games, which in turn is a continuation-in-part of U.S. Patent Application Serial No. 09/249,118 filed February 2, 1999 which in turn is a continuation-in-part of U.S. Patent Application Serial No. 09/170,092 filed October 13, 1998, now U.S. Patent No. 6,237,916 issued May 29, 2001, which is a continuation-in-part of U.S. Patent Application Serial No. 08/889,919 filed July 10, 1997 now U.S. Patent No. 6,056,641 issued May 2, 2000, which is a division of U.S. Patent Application Serial No. 08/504,023 filed July 19, 1995, now U.S. Patent No. 5,685,774 issued November 11, 1997" (Specification 1). See also p. 1 of the "**COMBINED DECLARATION AND POWER OF ATTORNEY**," filed February 2, 2004.

⁵ USPTO's records indicate that the filing date is November 1, 2001. This does not accord with the information in the Specification of the present application. The Examiner should check both and have the mistake corrected.

⁶ USPTO's records indicate that the filing date is February 12, 1999. This does not accord with the information in the Specification of the present application. The Examiner should check both and have the mistake corrected.

cannot be legally available as prior art under 35 U.S.C. § 102(b) *as long as* the present application is *entitled* to the benefit claimed under 35 U.S.C. § 120 of the filing dates of 10/016,436, 09/249,118, 09/170,092, 08/889,919, *and* 08/504,023. If the Examiner shows that the present application is *not entitled* to the benefit claimed under 35 U.S.C. § 120 of the filing dates of 10/016,436, 09/249,118, 09/170,092, 08/889,919, and 08/504,023, the Examiner will have shown that the present application has an effective filing date (September 9, 2003) that is more than one year after de Keller's issue date and will have supported the premise underlying the prima facie cases of unpatentability that de Keller is legally available as prior art under 35 U.S.C. § 102(b).

Entitlement to the benefit of filing dates of earlier applications is contingent on satisfying the conditions set forth in 35 U.S.C. § 120:

Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver

of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

35 U.S.C. § 120 (1999).

One way to show an application is *not entitled* to the benefit claimed under 35 U.S.C. § 120 of the filing date of an earlier application is to show that the earlier-filed application was not “filed by an inventor or inventors named in the previously filed application” (35 U.S.C. § 120).

In that regard, USPTO’s records indicate that the inventors of the present application are Mark L. Yoseloff and Roger M. Snow. This differs from the inventors named on any of the earlier-filed applications. According to USPTO’s records, which the Examiner should verify, the named inventors for each of the earlier-filed applications are:

10/016,436: Derek J. Webb and Roger M. Snow

09/249,118: Derek J. Webb

09/170,092: Derek J. Webb

08/889,919: Derek J. Webb

08/504,023: Derek J. Webb.

Complete identity of named inventors for each application in the chain is not required but there must be at least some overlap.

The 1984 amendment to § 120 plainly allows continuation, divisional, and continuation-in-part applications to be filed and afforded the filing date of the parent application even though there is not complete identity of inventorship between the parent and subsequent applications. D. Chisum, *Patents* Section 13.07 (1995). Thus, the Board erred in requiring complete identity of inventorship between the Doyle patent and the Chu application in

order for Chu to have the benefit of the Doyle patent's filing date. There is overlap in the inventive entities of the Doyle patent and the Chu application, which, after the 1984 amendment, is all that is required in terms of inventorship or "inventive entity" to have the benefit of an earlier filing date. But this does not determine whether Chu is entitled to the Doyle date.

In re Chu, 66 F.3d 292, 297, USPQ2d 1089, 1093 (Fed. Cir. 1995). Here, Roger M. Snow is listed as an inventor on the present application and on the 10/016,436 parent application. Accordingly, there is an overlap in named inventors for the present application and 10/016,436. But there is no overlap in named inventors for the present application and any of 09/249,118, 09/170,092, 08/889,919, and 08/504,023. If USPTO's records are accurate, the present application would *not* be entitled to the benefit of the filing dates of 09/249,118, 09/170,092, 08/889,919, and 08/504,023 because they were not "filed by an inventor or inventors named in the previously filed application" (35 U.S.C. § 120), leaving the filing date of 10/016,436, i.e., April 29, 2002, as the only possible earlier filing date to which the present application may be entitled. In that circumstance, de Keller would be legally available as prior art under 35 U.S.C. § 102(b).

Another way to show the present application is *not entitled* to the benefit claimed under 35 U.S.C. § 120 of the filing date of an earlier application is to show that the claimed subject matter was not "disclosed in the manner provided by the first paragraph of section 112 of this title in [the] application previously filed in the United States" (35 U.S.C. § 120). If USPTO's records on inventorship are inaccurate (in which case they should be updated), the present application would nevertheless still *not* be entitled to the benefit under 35 U.S.C. § 120 filing dates of

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any of 10/016,436, 09/249,118, 09/170,092, 08/889,919, and 08/504,023 fail to contain a disclosure which complies with 35 U.S.C. § 112, first paragraph, for each claim on appeal.

Section 120 . . . concerns only an applicant's effective filing date . . . and it expressly requires an earlier application to disclose the claimed subject matter in compliance with 35 U.S.C. § 112, first paragraph.

In re Scheiber, 587 F.2d 59, 62, 199 USPQ 782, 784 (CCPA 1978).

It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112. 35 U.S.C. § 120. *Mendenhall v. Cedarapids Inc.*, 5 F.3d 1557, 1566, 28 USPQ2d 1081, 1088-89 (Fed. Cir. 1993) ("A patentee cannot obtain the benefit of the filing date of an earlier application where the claims in issue could not have been made in the earlier application."), *cert. denied*, 511 U.S. 1031, 114 S.Ct. 1540, 128 L.Ed.2d 192 (1994); *see also Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1438, 221 USPQ 97, 106 (Fed. Cir. 1984) (discussing filing dates of CIP applications).

In re Chu, 66 F.3d 292, 297, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995). *See also Studiengesellschaft Kohle M.B.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564-65, 42 USPQ2d 1674, 1677-78 (Fed. Cir. 1997).

We observe that the Examiner found that the 08/504,023 application does not provide written descriptive support in accordance with the first paragraph of 35 U.S.C. § 112 for the subject matter on appeal (Answer 9). However, even if the Examiner is correct that the 08/504,023 application does not contain a disclosure which complies with 35 U.S.C. § 112, first paragraph, for each claim on appeal and, as a result, the present application is not entitled under 35 U.S.C. § 120 to the

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benefit of the filing date of the 08/504,023 application, the present application retains the presumption of having an effective filing date of at least July 10, 1997, i.e., the filing date of 08/889,919, the next earliest-filed application. That filing date falls *between* de Keller's filing date (September 11, 1995) and issue date (November 2, 1999) and would make de Keller legally available prior art under 35 U.S.C. § 102(e), not § 102(b).

In order for the Examiner to maintain the position that de Keller is legally available as prior art under 35 U.S.C. § 102(b), the Examiner would have to show that either the 10/016,436 or the 09/249,118 application does not contain a disclosure which complies with 35 U.S.C. § 112, first paragraph, for each claim on appeal. A showing of the former would establish that the present application is not entitled under 35 U.S.C. § 120 to the benefit of the April 29, 2002⁷ filing date of the 10/016,436 application for the subject matter of the claims on appeal. A showing of the latter would establish that the present application is not entitled under 35 U.S.C. § 120 to the benefit of the February 2, 1999⁸ filing date of the 09/249,118 application for the subject matter of the claims on appeal. In either case, the result would be that the present application would have an effective filing date more than one year after de Keller's issue date of November 2, 1999 for the subject matter of the claims on appeal, making de Keller legally available prior art

⁷ See footnote 5. Our analysis remains unaffected if the correct filing date is November 1, 2001.

⁸ See footnote 6. Our analysis remains unaffected if the correct filing date is February 12, 1999.

under 35 U.S.C. § 102(b). Note that in either case, it would not be necessary to further show that the present application is not entitled to the benefit under 35 U.S.C. § 120 of the filing dates of the other earlier-filed applications in the chain. This is so because a determination that an application is not entitled to the benefit under 35 U.S.C. § 120 of the filing date of an application breaks the chain of priority, preventing the application from securing the benefit of the filing date of any earlier application.

[T]here has to be a continuous chain of copending applications each of which satisfies the requirements of § 112 with respect to the subject matter presently claimed There must be continuing disclosure through the chain of applications, without hiatus, to ultimately secure the benefit of the earliest filing date.

In re Hogan, 559 F.2d 595, 609, 194 USPQ 527, 540 (CCPA 1977).

The application is remanded to the Examiner to reconsider the rejections in light of the comments in this decision. If the Examiner decides to continue to apply *de Keller* as prior art against the claims, the Examiner should clarify under which paragraph of 35 U.S.C. § 102 *de Keller* is legally available as prior art (i.e., §102(b) or (e)). In so doing, the Examiner will have to establish the effective filing date of the present application. That will entail determining that the subject matter of the appealed claims is *not* entitled to benefit under 35 U.S.C. § 120 of the filing dates of 10/016,436, 09/249,118, 09/170,092, 08/889,919, or 08/504,023. This

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can be done in either of two ways: (1) showing that the named inventors for the present application do not overlap with that of any of the earlier applications and (2) determining that an earlier application does not contain a disclosure which complies with 35 U.S.C. § 112, first paragraph, for each claim on appeal.

REMANDED

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